

# 16 Response
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9/23/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	GUHEEN ET AL.	Examiner:	R. POND
Serial No.:	09/322,073	Group Art Unit:	3625
Filed:	MAY 27, 1999	Docket No.:	8567.108US01
Title:	WEB-BASED ARCHITECTURE SALES TOOL (AS AMENDED)		

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, Alexandria, VA 22313-1450 on September 5, 2003.

By:

REQUEST FOR CLARIFICATION IN SUPPLEMENTAL OFFICE ACTION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action mailed May 21, 2003, Applicants respectfully request an advisory Supplemental Office Action to clarify the bases for rejections. Applicants believe that a supplemental Office Action is needed in this instance, for the reasons stated below. Alternatively, Applicants request a notice of Allowance.

To complete the record for appeal, Applicants respectfully request a Supplemental Office Action to clarify the bases for rejection of the claims. While Applicants acknowledge that the Examiner is not required to respond to this after-final communication, Applicants submit that a substantive response is appropriate in this instance because the Final Rejection contains facially apparent deficiencies. Applicants request that the Examiner reconsider and withdraw the rejections or at least clarify where the Examiner finds the motivation to combine the references further clarify how each element of the claims is taught by a particular reference, and provide references to support the assertions of Official Notice.

Claims 1, 2, 4-10, and 12-17 are pending in this application. In the Office Action, the Examiner rejected all the claims under 35 U.S.C § 103(a) based on the combination of three references and Official Notice. Applicants respectfully traverse these rejections. Applicants believe that the claims are in condition for allowance. To the extent that the Examiner relies on Official Notice and has not already supplied a reference, Applicants respectfully request the Examiner provide a reference to support the Official Notice.¹

Clarification of Official Notice

The Manual of Patent Examining Procedure (MPEP) cautions that Official Notice should be "judiciously applied." MPEP § 2143 (E). "The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." MPEP 2143 (B). "The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." MPEP 2143 (B). The MPEP requires that Applicants "specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." MPEP 2144(C). "If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained." Id.

The Examiner took "Official Notice (ON1) regarding the use of demonstration versions of software by sales and marketing personnel to provide onsite demonstrations to customers As a sales tool, a demonstratable version of NetOps' enhanced warning icon would be used to direct the target customer to service and/or product that could remedy the problem situation." (Final Office Action, p. 3, lines 16 to p. 4, line 1.)

Applicants request clarification regarding the Examiner's Official Notice. Applicants respectfully assert that the final office action is defective, in that it does not

¹ Applicants note the Examiner refers to "ON1" and "ON2" on pages 3 and 12 of the final Office Action, respectively. Applicants request references to support these and any other assertions of official notice.

clearly identify specific factual findings which are asserted on Official Notice (as required by MPEP § 2143 (B)) and does not identify which claim limitations are allegedly taught by the Official Notice.

Accordingly, Applicants request clarification of whether the Examiner relies upon features of the demo version of the NetOps software that are not taught by the article cited by the Examiner)(PTO-892 items V-W). Applicants also request specific identification and explanation of any such features of the NetOps software.

Applicants further request clarification of which elements of Applicants' claims the Examiner asserts are taught by Official Notice so that Applicants can traverse the Official Notice, as appropriate.

Finally, Applicants should "be allowed to challenge the assertion in the next reply after the Office action." MPEP § 2143(B). Applicants at least request withdrawal of the finality of the Office Action, as directed by MPEP § 2143(B). The Examiner's explanation of Official Notice in the October 22, 2002 office action and further elaboration in the May 21, 2003 final office action do not describe the nature of the official notice, or the elements taught thereby, with sufficient particularity for Applicants to fully traverse the notice.

Clarification of Prima Facie Case of Obviousness

The MPEP requires that three basic criteria must be met to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP § 2142.

Applicants respectfully submit that the first and third requirements have not been met. Applicants appreciate the Examiner's lengthy analysis of the references, but

respectfully request that the Examiner concisely identify where each element of the independent claims is taught in the cited references. For example, the Office Action does not describe how the following limitations from part (d) of claim 1 are taught in the references: "indicia coding the components of the existing network that relate to products or services that are likely to be purchased by the target market."

Applicants respectfully request that the Examiner clarify with succinct specificity where it is taught, and in which reference or combination of references, that indicia coding a pictorial representation of a component indicates a relationship to a product or service that is needed to implement an improvement plan.

The Examiner has also failed to provide adequate description of the motivation to combine the four references cited in support of the rejection. "The level of skill in the art cannot be relied upon to provide the suggestion to combine references." MPEP § 2141.03 "A statement that modification of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. MPEP § 2141.03 (quoting *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Examiner has stated that combinations would be obvious, but has not stated the motivation to combine the references. For example, the Examiner stated:

Therefore, it would have been obvious to one of ordinary skill in the art at [the] time of the invention to integrate the network management, modeling, and color coded, texturized, and shaded graphical visualizations as taught by Battat et al.

(Final Office Action, p. 8, lines 1-8.)

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of CACI and Battat et al., to use demonstratable versions of products as taught by ON1.

(Final Office Action, p. 8, line 21 to p. 9, line 6.)

Therefore, it would have been obvious to one of ordinary skill in the art at time of the invention to use the integrated management software and software tools of CACI, Battet et al. and ON1 as a source of modeling, performance, and graphical information to be indicia coded as taught by Ruffin et al. in order to relate products and services determined to address customer needs, and thereby help decision makers better understand which solutions are necessary at various points in the infrastructure.

(Final Office Action, p. 10, lines 10 to 16.)

The Examiner has argued that the references can be combined to provide the elements recited in the claims but has not articulated a motivation to combine the reference in such a manner, except that the combination would achieve the claimed features.

To clarify this matter for appeal, Applicants request that the Examiner clarify where the Examiner finds the motivation to combine the references in the prior art or reconsider and withdraw the rejections.

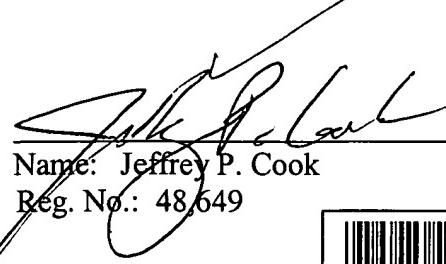
Summary

In summary, Applicants believe that the Final Office Action does not describe how each element is taught by the cited references and does not articulate a motivation to combine the references to provide the claimed subject matter. Thus, the Examiner has not established a *prima facie* case of obviousness. The Examiner's use of Official Notice also does not describe the specific factual findings and claim elements that are covered by the Official Notice. Applicants respectfully request that the Examiner provide a supplemental office action to provide clarification the rejections, withdrawal of the

finality of the last office action, or, alternatively, reconsideration and withdrawal of the rejections.

Respectfully submitted,
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Date: September 5, 2003


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